

PATENT  
P56254

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

SANG-JIN LEE

Serial No.: 09/727,513

Examiner: CHAI, LONGBIT

Filed: 4 December 2000

Art Unit: 2131

For: APPARATUS AND METHOD FOR FAST BOOTING

**PETITION UNDER 37 CFR §1.181**

**Mail Box: AF**

Commissioner for Patents

P.O.Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant petitions the finality of a January 4, 2005 Final Office action.

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Date: 3/28/05

I.D.: REB/ML/gc

**STATEMENT OF FACTS**

1. On June 8, 2004, a first Office action (Paper No. 3) was mailed rejecting all pending claims.
2. On September 25, 2004, Applicant filed an amendment in response to Paper No. 3 traversing all claim rejections.
3. On January 4, 2005, a Final Office action (Paper No. 20041215) was mailed again rejecting all pending claims. In the Final Office action, the Examiner changed his position regarding the rejection.

**ARGUMENT AND/OR REMARKS**

Applicant hereby petitions under 37 CFR §1.181 the finality of the Final Office action. Applicant submits that the new grounds for rejection in the Final rejection were not necessitated by Applicant's September 25, 2004 amendment.

In independent claims 10 and 11, Applicant claims setting an instruction pointer of a central processing unit to point to a boot image in main memory. In the June 8, 2004 Office action, the Examiner says that this feature is taught by col 2, line 68, col 3, lines 23-37 col 3, line 1 and element 12 of FIG. 1 of USP 5,448,741 to Oka in the rejection of claim 10 on page 4. The Examiner also says that this feature is taught that col 1, lines 21-23 of USP 6,098,158 to Lay when rejecting claim 11 on page 5 of the June 8, 2004 Office action.

In the September 25, 2004 amendment, Applicant did not amend either of these claims. Instead, Applicant traversed their rejections by arguing that the cited sections of Lay and Oka do not teach this instruction pointer feature.

The Examiner responded in the January 4, 2005 office action that this instruction pointer feature is inherent. This assertion of inherency was not produced in the June 8, 2004 Office action.

Applicant submits that this is a change of position on the part of the Examiner that was not necessitated by an amendment. The Examiner shifted his position regarding the rationale for

rejecting the instruction pointer limitation of claims 10 and 11 from the references of Lay and Oka to now saying that the instruction pointer feature is inherent. Applicant submits that such a change of rejection should not be final as it was not necessitated by an amendment. Applicant has never had a chance to respond to the inherency allegation and that this is in violation of MPEP 706.07 (a).

Likewise, in the June 8, 2004 Office action, the Examiner rejected claims 1, 2, 3 and 6 under 35 U.S.C. 102 (b) using only the reference to Oka. In the September 25, 2004 amendment, Applicant traversed the rejection. Applicant also amended claim 1 to correct for minor errors in two words. In the January 4, 2005 Office action, the Examiner then rejected claims 1, 2, 3 and 6 under 35 U.S.C. 103 (a) using Lay in view of Oka and made this rejection Final. Applicant submits that the change in the grounds of the rejection was not necessitated by Applicant's amendments.

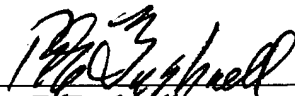
Therefore, Applicant submits that the January 4, 2005 Final Office action was premature.

**RELIEF REQUESTED**

Therefore, in view of the foregoing, the Commissioner is respectfully requested to:

- A. Vacate the Finality of the January 4, 2005 Office action;
- B. Issue a new non-Final Office action and reopen prosecution; and
- C. Grant Applicant such other and further relief as justice may require.

Respectfully submitted,

  
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